

## **Remarks**

### **Introduction**

Applicant herein cancels claims 19-26 and 37 to simplify issues after a final rejection.

Claims 1-18 and 38 remain pending and not amended from the previous response.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

### **The Office Action's Rejections**

#### **§ 102(b)**

Claims 1-5, 8, and 38 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fey. Applicant respectfully traverses. Applicant notes that the Patent Office has inconsistently interpreted the term “game parameter” relative to the elements within Fey. Anticipation requires identity between the reference and the claim, and this identity has not been established in the present application as evidenced by the Patent Office’s own internally inconsistent interpretation of the reference.

Claim 1 recites determining a game parameter and setting an actual value of the game parameter based on the randomly selected displayed symbol. The game parameter has been further defined through Applicant’s previous amendment. In Applicant’s last response, Applicant argued that the payout of Fey is not a game parameter.

In the current Office Action, the Patent Office both clarifies and muddles its explanation of its interpretation of Fey. Specifically, the Patent Office initially identifies the payable as the game parameter of the claim, asserting that the payable controls at least one element of the game such it effects the manner in which the game will be conducted – namely which combinations win and how much is paid for winning combinations. (Office Action of 27 April 2006, p. 2, lines 12-16). Since the claim recites determining a game parameter and setting an actual value of the game parameter based on the randomly selected displayed symbol, under the Patent Office’s interpretation, to meet the claim, an actual value of the payable must be set based on the randomly selected displayed symbol. Perhaps realizing that the payable is not set based on a symbol, the Patent Office, in its subsequent analysis, changes interpretations and says that the payout depends on which symbols appear on the payline. (Office Action of 27 April 2006, p. 2,

lines 20-22). As the Patent Office has previously identified the payable as the parameter (**not the payout**), it is irrelevant in an anticipation analysis if the payout depends on the symbol. For anticipation, the reference must be identical to the claim. MPEP § 2131. Fey does not set his payable based on the randomly selected displayed symbol, so either the payable is not the game parameter as identified by the Patent Office, or the game parameter is not set as claimed. Either way, the claim is not anticipated.

The Patent Office provides additional analysis in its “Response to Arguments” section. Specifically, the Patent Office opines that Applicant does not claim when the parameters are set, and thus, the parameter (i.e., the payable) may be set at the factory. (Office Action of 27 April 2006, p. 6, lines 7-10). While Applicant does not recite in claim 1 when the parameter is set, Applicant does recite in claim 1 on what the parameter is set – the randomly selected displayed symbol. The Patent Office has provided no analysis that a randomly selected displayed symbol is used to set the payable so as to anticipate the claim properly.

In short, the Patent Office has not shown where the elements of the reference are arranged as claimed, and Fey does not anticipate claim 1. Since Fey does not anticipate claim 1, Fey cannot anticipate claims 2-5, 8, and 38, which depend from claim 1.

Claims 5 and 8 deserve special mention in that they provide further language for what the game parameter represents. Specifically, claim 5 recites that the game parameter represents a number of game symbols with which to start a session, and claim 8 recites that the game parameter represents a number of reels used in a game. The Patent Office asserts that “the game parameter **could** also represent a number of game symbols” and “[t]he game parameter **could** represent a number of reels used in a game.” (Office Action of 27 April 2006, p. 3, lines 6 and 11 respectively, emphasis added). Anticipation requires more than mere possibilities. Anticipation requires identity between the reference and the claim language. The fact that something **could** be present is insufficient to establish anticipation. Additionally, to the extent that claims 5 and 8 depend from claim 1, claim 5 effectively recites that the number of game symbols is set based on the randomly selected displayed symbol, and claim 8 effectively recites that the number of reels used in a game is set based on the randomly selected displayed symbol. Neither is taught or suggested by Fey. To this extent, even if the payable of Fey is a game parameter (a point which Applicant does not concede), claims 5 and 8 are independently

patentable because Fey does not teach setting the number of reels or the number of game symbols based on the randomly selected displayed symbol as recited in claims 5 and 8.

While claims 5 and 8 are argued separately, nothing in their separate arguments should be taken as an admission that claims 2-4 and 38 are likewise not anticipated.

In view of the foregoing, Applicant respectfully requests withdrawal of the § 102(b) rejection of claims 1-5, 8, and 38 at this time.

Claims 19-26 and 37 were rejected under 35 U.S.C. § 102(b) as being anticipated by Walker et al. (U.S. Patent No. 5,511,784). Applicant initially notes that U.S. Patent No. 5,511,784 is to Furry et al., not Walker et al. As such, the Patent Office has not set forth a clear basis for the rejection.

Applicant cancels claims 19-26 and 37 to simplify issues after a final rejection, thereby mooted the rejection for the moment. Applicant reserves the right to pursue the subject matter of these claims in a continuation application and requests that, when Applicant does so, the Patent Office clarify the basis of the rejection.

### § 103

Claims 6, 7, and 9-18 were rejected under 35 U.S.C. § 103 as being unpatentable over Fey in view of Walker et al. (U.S. Patent No. 6,068,552, hereinafter “Walker ‘552”) and Applicant’s disclosure. Applicant respectfully traverses. For the Patent Office to combine references in an obviousness determination, the Patent Office must do two things. First, the Patent Office must set forth a motivation to combine the references, and second, the Patent Office must set forth actual evidence to support the motivation. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Furthermore, “to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant’s disclosure or the mere fact that the components at issue are functional or mechanical equivalents.” MPEP § 2144.06 (citation omitted). As final note, to establish *prima facie* obviousness, the burden is on the Patent Office to show where each and every element of the claim is found in the references. MPEP § 2143.03. If the Patent Office cannot establish *prima facie* obviousness, then Applicant is entitled to a patent. 35 U.S.C. §§ 102 & 103.

Applicant initially traverses the rejection because the Patent Office’s motivation does not compel the combination. The Patent Office states that Walker ‘552 teaches that allowing parameters to be changed on the fly induces player to continue playing for extended periods of

time. (Office Action of 27 April 2006, p. 5, lines 14-15). Assuming, *arguendo*, that the statement is true, the statement does not compel the combination. Rather, someone seeking to induce players to continue playing for extended periods of time would look no further than Walker '552, and would not seek to combine Walker '552 with another reference. The motivation must suggest the combination. If a single reference completely satisfies the motivation, then the motivation does not suggest a combination. As such, the motivation advanced by the Patent Office is insufficient to support the combination. Since the motivation is insufficient to support the combination, the combination is improper. Since the combination is improper, the rejection based thereon is improper. Applicant requests withdrawal of the improper § 103 rejection of claims 6, 7, and 9-18 at this time.

Applicant further notes that the Patent Office is not allowed to use Applicant's disclosure to prove equivalency. MPEP § 2144.06. Thus, it is inappropriate for the Patent Office to comment that "Applicant teaches that all of these various game parameters are equivalent." (Office Action of 27 April 2006, p.5, lines 19-20). Even if it were appropriate to use Applicant's disclosure in this manner (a point which Applicant does not concede), the Patent Office has not provided a proper motivation to modify the combination of Fey and Walker '552 to include these various parameters. That is, the Patent Office relies on the same statement that Walker '552 teaches that changing parameters induces players to continue playing for extended periods of time. But, as noted above, a person motivated by such a factor only looks to Walker '552 and does not look past Walker '552 to solve the problem raised by the motivation. Since the motivation does not compel the combination, the combination is improper. Since the combination is improper, the rejection based thereon is improper. Applicant requests withdrawal of the improper § 103 rejection of claims 6, 7, and 9-18 at this time.

In its "Response to Arguments" section, the Patent Office explains how Applicant proves the game parameters equivalent. However, the quotation of Applicant's disclosure just confirms that the Patent Office relies exclusively on Applicant's disclosure to prove equivalency, which is specifically prohibited by the MPEP.

Since the Patent Office has not properly supported the motivation to combine the three references, and the Patent Office is not allowed to use Applicant's disclosure to prove equivalency, the rejection does not show all the elements of the claims. Since the rejection does

not show all the elements of the claim, the rejection does not establish *prima facie* obviousness, and the claims are allowable.

### **Conclusion**

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Taylor M. Davenport at telephone number 203-461-7228 or via electronic mail at [tdavenport@walkerdigital.com](mailto:tdavenport@walkerdigital.com), at the Examiner's convenience.

### **Authorization to Charge Fees**

Applicants do not believe an extension of time to make this Amendment and Response timely is necessary. However, should an extension of time be necessary, please grant a petition of an extension of time necessary to make this submission timely. Additionally, please charge any fees that may be required for this submission as follows:

Deposit Account: 50-0271

Order No. 03-011

Charge any additional fees or credit any overpayment to the same account.

*A duplicate copy of this authorization is enclosed for such purposes.*

Respectfully submitted,

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Date

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